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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,449	12/30/2003	Richard D. Keeven	1671-0281	2371
28078 7590 02/01/2011 MAGINOT, MOORE & BECK, LLP CHASE TOWER 111 MONUMENT CIRCLE SUITE 3250 INDIANAPOLIS, IN 46204				
EXAMINER WOODALL, NICHOLAS W				
ART UNIT 3775		PAPER NUMBER		
MAIL DATE 02/01/2011		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/748,449

**Applicant(s)**

KEEVEN ET AL.

**Examiner**

Nicholas Woodall

**Art Unit**

3775

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-43 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-32 and 35-43 is/are allowed.
- 6) ☒ Claim(s) 24, 33 and 34 is/are rejected.
- 7) ☒ Claim(s) 25-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/18/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to applicant's amendment received on November 18<sup>th</sup>, 2010.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 24, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufman (U.S. Patent 4,721,104).

Kaufman discloses a device comprising an instrument, an augment (5), and a femoral resection guide (60), wherein the device is configured such that when the system is assembled and the femoral resection guide is positioned on a femur, the instrument and the augment span a gap between the femur and a tibia. The instrument includes a positioning member (61) defining a femur facing side and a planar tibia facing side. The positioning member includes a first coupler (65) and a connector member comprising a first mating feature (a bore receiving or created by screw 62; column 5 lines 1-7). The augment includes an upper surface, a contoured lower surface, and a second coupler (92) that cooperates with the coupler to fix the augment to the positioning member, wherein the upper surface of the augment abuts the tibia facing side of the positioning member. The femoral resection guide includes a second mating feature (62) that mates with the first mating feature.

***Allowable Subject Matter***

4. Claims 28-32 and 35-43 are allowed.
5. Claims 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed November 18<sup>th</sup>, 2010 have been fully considered but they are not persuasive. The applicant's argument that the Kauffman reference does not disclose a device as described in claim 24 is not persuasive. The applicant argues that the Kauffman reference does not disclose a device wherein the femoral resection guide is mounted to a femur that the instrument and the augment span a gap between the femur and the tibia. During a surgical procedure on the knee, the knee is usually bent at an approximately 90 degree angle putting the tibia in a position that is below and a little forward of the femur (see Figure 2 of the current application). In this position there is a space/gap between the tibia bone and the femur bone that encompasses an immediate area distal the femur and the proximal surface of the tibia (the space/gap filled by element 20 and portion 30 of element 26 in Figure 2 of the application) and an area between the posterior surface of the femur and the proximal surface of the tibia (the space/gap filled by portion 28 of element 26 in Figure 2 of the application). When the device of Kauffman is positioned on the distal end of the femur, the augment and the instrument would fill the space/gap that is immediate the distal area of the femur (the space filled by element 20 and portion 30 of element 26 in Figure 2 of the application).

Therefore, the Kauffman reference reads upon the limitations of the claims as presented by the applicant. The examiner recommends adding language from on of the objected dependent claims or to further clarify the gap disclosed by adding modifiers such as the gap between the tibia and the femur defined by a posterior surface of the femur and a proximal surface of the tibia. The examiner has provided new grounds of rejection as necessitated by the amendment making this office action **FINAL**.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775